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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SORKIN, DAVID L

ART UNIT PAPER NUMBER

1723

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,338

Applicant(s)

MAGUIRE, STEPHEN B.

Examiner

David L. Sorkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) 31-48, 53-67 and 83-96 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 and 26 is/are allowed.
- 6) ☒ Claim(s) 1-24, 27-30, 49-52 and 68-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09 May 2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 May 2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-24 and 27-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. These claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Claim 1 has been amended to recite "resilient means resident in said first chamber contacting said first side of said diaphragm to bias said diaphragm toward said first chamber". While the originally filed application describes "spring 38" resident in said first chamber contacting said first side of said diaphragm, the spring biases that diaphragm away from the first chamber. See page 11, lines 6-7 of the original specification, which read "constant

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application of bias by spring 38 against lower or downwardly facing surface 126 of diaphragm 36". See also original claim 14, which read "means for biasing said diaphragm away from said cavity". Applicant makes clear in applicant's 9 May 2005 remarks on the page numbered "36" that claim 1 has been intentionally amended in the above-described manner to overcome Conover (US 2,656,828).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14-24 and 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Upon the amendment of claim 1 to require, for example, a "diaphragm", "mean ... for reciprocally displacing" and "means... to bias", the recitation of similar features in depending claims 14, such as "a flexible diaphragm", "means for cyclically displacing", and "means for biasing" is confusing as to whether these are the same as those recited in the parent claims or additional elements. The two biasing means recitation (claim 1 vs. claim 14) are contradictory as to the direction of biasing.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 68-70, 72-74 and 77-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Siczek (US 3,957,399). Regarding claim 68, Siczek ('399) discloses an apparatus comprising a container (10); a rod (20 and in the alternative 42,43,46) reciprocally displaceable into said container (see col. 3, lines 12-15); and said container including a valve (28,30) opening to permit liquid flow from said container responsive to reciprocation of said rod. Regarding claim 69, said container is sealable (see col. 3, lines 1-3; Fig. 1). Regarding claim 70, while the reference states that the container may contain "paint" (see col. 3, lines 9-10), applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458,459 (CCPA 1963) and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault* 164 USPQ 666,667 (Bd. App. 1969). Regarding claim 72, the rod is mechanically actuated (see col. 2, lines 5-6). Regarding claim 73, said rod is electrically powered (see col. 2, lines 59-61). Regarding claim 74, a piston (20) is for drivingly reciprocating said rod (42,43,46). Regarding claim 77, said rod forms a part of a pump further comprising a body (23,25) within the container, having a cavity; a diaphragm (24) bounding a portion of said cavity; said rod providing means for displacing said diaphragm at least part way into said cavity to displace liquid (see col. 3, lines 16-28); said diaphragm flexing away from said cavity during a portion of a rod reciprocation (see col. 3, lines 16-28). Regarding claim 78, said diaphragm flexes away from said cavity upon retracting movement of said rod relative to said diaphragm and cavity (see col. 3,

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lines 16-28; col. 5, lines 59-67). Regarding claim 79, said diaphragm resiliently self flexes away from said cavity upon retracting movement of said rod relative to said diaphragm (see col. 3, lines 16-59). Regarding claim 80, said diaphragm relaxes upon retracting movement of said rod relating to said cavity (see col. 3, lines 16-59).

Regarding claim 81, said diaphragm relaxes upon retracting towards a position from which said rod displaces said diaphragm into said cavity (see col. 3, lines 16-59).

Regarding claim 82, the apparatus further comprises means (39) for biasing said diaphragm towards a position from which said rod displaces said diaphragm into said cavity.

8. Claims 68-72 and 74-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Miner (US 2,606,696). Regarding claim 68, Miner ('696) discloses an apparatus comprising a container (T), a rod (18) reciprocally displaceable into said container; and said container including a valve (27) opening to permit liquid flow from the container responsive to reciprocation of said rod. Regarding claim 69, said container is sealable (see Fig. 1). Regarding claim 70, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto* 136 USPQ 458,459 (CCPA 1963) and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault* 164 USPQ 666,667 (Bd. App. 1969). Regarding claim 71, said rod is pneumatically actuated (see col. 1, lines 4-6). Regarding claim 72, said rod is mechanically actuate (by piston 16). Regarding claim 74, a piston (16) for drivingly

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reciprocating said rod. Regarding claim 75, said piston is pneumatically actuated (see col. 1, lines 4-6). Regarding claim 76, said piston would be capable of being hydraulically actuated (see col. 1 line 50 to col. 2 line 22).

9. Claims 49, 50 and 68-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Conover (US 2,656,828). Regarding claim 49, Conover ('828) discloses a container (30) having a quick disconnect fitting for output of liquid (see col. 5, line 48 to col. 6 line 41; Figs. 8 and 10); means within said container, for pumping liquid out of said container responsive to pressurized gas furnished thereto (see col. 2 line 54 to col. 3 line 6) comprising an upper portion (45); a body portion (46) connected to said upper portion, having an open interior cavity facing said upper portion, a liquid inlet facing communicating with said open interior cavity and an outlet also communicating with said inlet (see Fig. 3); a check valve (53) within said inlet for permitting inflow of liquid from within said container into said open interior cavity but blocking outflow from said open interior cavity into said container; a diaphragm (47) between said upper portion and said open interior of said body, edges of said diaphragm being sandwiched between said upper portion and said body, being distendable towards and into said open interior cavity of said body responsively to application of force to a diaphragm side facing oppositely from said open interior cavity to displace liquid having entered said open interior cavity to displace liquid having entered said open interior of said body through said inlet orifice from said body through said outlet and out of said container via an outlet connection by urging a diaphragm surface facing said open interior cavity of said body against liquid present therein (see col. 3, line 44 to col. 4 line 23); and a spring

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(59) for biasing said diaphragm away from said open interior. Regarding claim 50, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto supra.* and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault supra.* Regarding claim 68, Conover ('828) discloses an apparatus comprising a container (30), a rod (57) reciprocally displaceable into said container; and said container including a valve (53) opening to permit liquid color flow from said container responsively to reciprocation of said rod. Regarding claim 69, said container is sealable (see col. 2, line 54). Regarding claim 70, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto supra.* and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault supra.* Regarding claim 71-73, 75 and 76 as explained above regarding claims 6-8, the rod and piston would be capable of being pneumatically, hydraulically, electrically, or mechanically actuated. Regarding claim 74, a piston (58) is for drivingly reciprocating said rod. Regarding claim 77, said rod forms part of a pump further comprising a body (46) having a cavity formed therein; a diaphragm (47) bounding a portion of said cavity; said rod providing means for displacing said diaphragm at least part way into said cavity to displace liquid therefrom; said diaphragm flexing away from said cavity during a portion of a rod reciprocation (see Fig. 3; col. 3, line 44 to col. 4 line 23). Regarding claim 78, said diaphragm flexes away



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from said cavity upon retracting movement of said rod relative to said diaphragm and said cavity (see Fig. 3; col. 3, line 44 to col. 4 line 23). Regarding claim 79, said diaphragm resiliently self-flexes away from said cavity upon retracting movement of said rod relative to said diaphragm (see col. 3, line 44 to col. 4 line 23). Regarding claim 80, said diaphragm relaxes upon retracting movement of said rod relating to said cavity (see col. 3, line 44 to col. 4 line 23). Regarding claim 81, said diaphragm relaxes upon retracting movement of said rod away from said diaphragm (see col. 3, line 44 to col. 4 line 23). Regarding claim 82, means (59) biases said diaphragm towards a position from which said rod displaces said diaphragm into said cavity (see col. 3, line 44 to col. 4 line 23).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 51 and 52 rejected under 35 U.S.C. 103(a) as being unpatentable over Conover (US 2,656,828) in view of Miner (US 2,606,696). Regarding claim 51, Conover ('828) discloses an apparatus comprising a container (30) having an outlet connection (see col. 5 line 47 to col. 6 line 41; Figs. 8 and 10); a reciprocable rod (57) within said container; diaphragm pump means housed at least partially within said container, for pumping liquid out of said container via said outlet connection comprising an upper housing part (45) having a relief with an aperture therein (see Fig. 3; col. 3 line 44 to col.

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4 line 23); a body (46) connected to said upper housing part and having an open interior cavity facing said relief of said upper housing part, said body having a liquid inlet aperture communicating with said open interior cavity an outlet aperture communicating with said open interior remotely from said inlet aperture (see Fig. 3; col. 3 line 44 to col. 4 line 23); a check valve (53) at said inlet aperture for permitting inflow of liquid from within said container into said open interior cavity but blocking efflux of said liquid outwardly from said open interior cavity through said inlet aperture; a diaphragm (47) between said upper housing part and said open interior cavity of said body, being distendable towards and into said open interior cavity of said body responsively to axial reciprocating movement of said rod through said aperture in said relief of said upper housing part to serially displace liquid in said open interior cavity from said body through said outlet orifice and out of said container via said outlet connection (see Fig. 3; col. 3 line 44 to col. 4 line 23); and a spring (59) for biasing said diaphragm away from said open interior portion of said body and into space proximate said relief. The rod (57) of Conover ('828) is connected to piston (58), which is intended to be manually actuated. The claimed "pneumatic piston-cylinder combination" is not disclosed by Conover ('828). Miner ('696) taught a pneumatic piston-cylinder combination (14,16) removably connected to a container (T), for providing pneumatically driven reciprocation of an output shaft portion (a portion of 18) thereof. It is considered that it would have been obvious to one of ordinary skill in the art to have provided the apparatus of Conover ('828) with the pneumatic piston-cylinder combination of Miner ('696), because Miner ('696) explains that the purpose of this aspect of his invention is to automate hand

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operated pumps (see col. 3, lines 18-20), while the pump of Conover ('828) is hand operated. Regarding claim 52, applicant is advised that "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto supra*. and "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim" *Ex parte Thilbault supra*.

***Allowable Subject Matter***

12. Claims 25 and 26 are allowed.

***Response to Arguments***

13. Applicant has not amended claims 49-52 and 68-82 and has not made any arguments regarding the patentability of these claims. The previous grounds for rejection of these claims have been maintained and repeated.

14. Claim 1 has been amended to, among other things, require a diaphragm pump, while Miner (US 2,606,696) does not involve a diaphragm pump.

15. Claim 1 has also been amended to require "resilient means resident in said first chamber contacting said first side of said diaphragm to bias said diaphragm toward said first chamber", which the other previously applied references do not disclose. However, as explained above, the instant application as originally filed also did not describe this limitation.

16. Applicant states that "the spring involved in applicant's valve only operates to bias the diaphragm once the diaphragm has been displaced by the mechanical part of applicant's pump". However, as expressly stated on page 11, lines 6-7 of the instant


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specification there is "constant application of bias by spring 38 against lower or downwardly facing surface 126 of diaphragm 36".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David L. Sorkin  
Primary Examiner  
Art Unit 1723

DLS